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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,192	04/16/2004	Edwin C. Iliff	ILIFF.2DV3DVC	2329

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EXAMINER	
DAVIS, GEORGE B	

ART UNIT	PAPER NUMBER
2129	

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/827,192	EDWIN C. ILIFF	
	Examiner	Art Unit	
	George Davis	2129	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-33 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) 23-33 is/are allowed.

6)☒ Claim(s) 1-22 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 20050712.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. **Notice of Allowability mailed February 22, 2005 is withdrawn.**

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 14-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 24-31 of U.S. Patent No. 6,071,236. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

As per claim 14, Iliff discloses automatically providing a patient an item of information prestored in a computing device memory (Claim 24, column 68, lines 16 and 17), automatically waiting a predetermined time interval (Claim 24, column 68, line 18), automatically asking the patient about the item of information (Claim 24, column 68, lines 19 and 20), automatically comparing an answer from the patient to a prestored

expected answer (Claim 24, column 68, lines 23 and 24) and automatically evaluating a mental status of a patient based on the comparison (Claim 24, column 68, lines 25 and 26). The 14 does not recite the phrase "computer executes instructions to process the answer so as to automatically receive the answer". However, although the conflicting claims are not identical, they are not patentably distinct from each other because an omission of an element and its function where not needed is obvious. See *Ex Parte Rainu,* 168 USPQ 375 (PTO Board of Appeals 1969).

As per claim 18, Iliff discloses automatically asking a patient for an item of information, wherein a first request for the item of information is prestored in a computing device memory (Claim 27, column 68, lines 38-40), automatically receiving a first answer (Claim 27, column 68, line 42) automatically waiting a predetermined time interval (Claim 27, column 68, line 43), automatically asking the patient about the item of information in a different manner, wherein a second request for the item of information is prestored in the computing device memory (Claim 27, column 68, lines 44-47), automatically receiving a second answer (Claim 27, column 68, line 49), automatically comparing the first answer to the second answer (Claim 27, column 68, lines 50 and 51) and automatically evaluating mental status of a patient based on the comparison (Claim 27, column 68, lines 52 and 53). Claim 18 does not recite the phrase "computer executes instructions to process the answer so as to automatically receive a first and second answer". However, although the conflicting claims are not identical, they are not patentably distinct from each other because an omission of an

element and its function where not needed is obvious. See *Ex Parte Rainu,* 168 USPQ 375 (PTO Board of Appeals 1969).

Also, claimed invention (claims 15-17 and 19-22) are taught by Iliff's patent (claims 25-27 and 29-31).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Altman et al, U.S. Pat. No. 5572421 in view of Brill, U.S. Pat. No. 5445324.

As per claims 1, 10 and 12, Altman discloses an automated diagnostic consulting using an automated medical advice or diagnostic system (portable medical questionnaire presentation device 20, figure 1) including a computer device (microcomputer 52, figure 4) and input (patient keypad 26) and output (text display 22) devices. Further Altman et al discloses prestoring questions and corresponding expected answers in memory (ROM 138, column 9, lines 31-40), automatically asking a patient one of the prestored questions (figure 3D), automatically comparing the answer to a corresponding prestored expected answer (column 20, lines 10-13 and automatically ascribing the score to a result of a comparison ("calculating a weighted numerical value based on the answer", at column 16, lines 16-26). Altman does not teach automatically comparing the score to a predetermined threshold value so as to

determine a mental status of a patient. However, Altman (teaches at column 9, lines 62-65, and column 10, lines 23-29, that a "large variety of specialized questionnaires may be provided to target specific health-related targeting particular health risks and medical conditions" and that the system is "easily adaptable" to present various questionnaires by "changing the text of the questions to be presented to a patient and by describing appropriate steps for analyzing the patient's answers". For instance, Brill teaches an apparatus for "measuring and quantifying a patient's psychological condition" and for "administering psychotherapy based on such measurements" (se column 1, lines 11-15, column 2, lines 31-40, column 4, lines 52 and 53, Appendix A). Brill also teaches comparing the score of a predetermined threshold value (benchmark) to determine a patient's mental state (see column 7, lines 28-37, column 8, lines 14-17). Thus, it would have obvious to one of ordinary skill of the art at the time the invention was made to include in Altman's device a questionnaire to determine the mental status of a patient as in Brill because it provides an objective and reliable method for measuring a person's mental state.

AS per claims 2-9, 11 and 13, Altman does not teach in details recite patient information history including mental status, threshold value and assistance if threshold value not achieved and a third part assistance if needed. However Brill teaches patient information history including mental status, threshold value and assistance if threshold value not achieved and a third part assistance if needed ("benchmark" and column 7, lines 28-37, column 8, lines 14-17). It would have obvious to one of ordinary skill of the art at the time the invention was made to include in Altman's device a questionnaire to

determine the mental status of patient as in Brill because it provides an objective and reliable method for measuring a person's mental state.

Allowable Subject Matter

4. Claims 23-33 are allowed.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Davis whose telephone number is (571) 272-3683. The examiner can normally be reached on Monday through Friday from 10:00 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight, can be reached on (571) 272-3687. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-3800.

July 8, 2005

GEORGE B. DAVIS
PRIMARY PATENT EXAMINER